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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/058,126

01/29/2002

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3487

466 7590 01/25/2007
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EXAMINER

TINKLER, MURIEL S

ART UNIT

PAPER NUMBER..

3691

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

01/25/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS* from the mailing date of this communication.

Office Action Summary	Application No. 10/058,126	Applicant(s) GEFWERT ET AL.	
	Examiner Muriel Tinkler	Art Unit 3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>See Continuation Sheet</u> . | 6) <input type="checkbox"/> Other: _____ |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :1/29/2002, 2/19/2004, 4/22/2002.

DETAILED ACTION

This application has been reviewed. The original claims 1-19 are pending. The restrictions are as stated below.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 12, 15 rejected under 35 U.S.C. 102(b) as being clearly anticipated by Schmitz (US 6,078,908).

3. Claims 1, 12 and 15 discuss a method (101) and arrangement (200, 300) for offering a service in an information network, characterized in that data related to a transaction are transferred (102) in an open network, said data are accepted (104) and the acceptor of the data is identified (107) through authentication performed in a closed network. Schmitz discloses on page 5 and lines 3-6, "The present invention can be universally employed in the region of data transmission systems. This holds for example also for the Internet and intranets, local area networks LAN, wide area networks WAN, etc." Schmitz also discloses on page 1 and lines 45-62, "The present invention provides for a method for the authorization of data transmission systems. A qualifying identification of a user is entered into a data input apparatus. The qualifying

identification and a request for an authorization signal is transmitted from the data input apparatus to an authorization computer along a first transmission path. The authorization signal is established in the authorization computer. The authorization signal is sent from the authorization computer to a monitor along a second transmission path different as compared to the first transmission path. The authorization signal at the monitor is read by the user. The authorization signal is entered into the data input apparatus. The authorization signal is transmitted from the data input apparatus to the authorization computer. The validity of the authorization signal is verified in the authorization computer. A connection is established between the data input apparatus and a receiver unit upon verification of the validity of the authorization signal."

4. Claims 2 and 13 discuss a method according to claims 1 and 12, characterized in that said acceptance of data comprises steps in which accepting the data related to said transaction is performed (104) by entering a code at a terminal (207) of a closed network, said code entered at a terminal is identified and authenticated (105), and said data related to the acceptance of a transaction are transferred (412, 413) to a service provider (203, 205) via a closed network. Schmitz discloses using the method and apparatus of claims 1 and 12. Claims 1 and 12 were rejected based on the discussion(s) above. Schmitz discloses using the method of claim 1 via a closed network (such as a LAN or intranet), as disclosed in claim 1.

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5. Claim 3 discusses a method according to claim 1, characterized in that said transaction is a commercial transaction (401). Schmitz discloses using the method of claim 1. Claim 1 was rejected based on the discussion(s) above. Schmitz does disclose the use of the system to include commercial operations such as banks and garages on page 5 and lines 34-48, "The concrete fields of application comprise, for example: computer centers; airports; ministries, government offices; customs; border transition points; security regions; banks; police and military applications; shielded storage, vaults, bank vaults; garages; parking houses; and automobiles."

6. Claim 5 discusses a method according to claim 1, characterized in that the parties associated with the transfer of data are identified by a service provider (203, 205). Schmitz discloses using the method of claim 1. Claim 1 was rejected based on the discussion(s) above. Schmitz discloses on page 1 and lines 45-50 and page 1 and lines 58-62, "The present invention provides for a method for the authorization of data transmission systems. A qualifying identification of a user is entered into a data input apparatus. The qualifying identification and a request for an authorization signal is transmitted from the data input apparatus to an authorization computer along a first transmission path... The validity of the authorization signal is verified in the authorization computer. A connection is established between the data input apparatus and a receiver unit upon verification of the validity of the authorization signal."

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7. Claim 8 discusses a method according to claim 1, characterized in that the decryption of data related to said transaction is performed using a service user's terminal (207). Schmitz discloses using the method of claim 1. Claim 1 was rejected based on the discussion(s) above. Schmitz discloses on page 4 and lines 47-48, "It is clear that the transmission to such receiver apparatuses can also be encoded and/or encrypted." While Schmitz does not specifically state that the receiver has a decryption module, it would be obvious to a person known in the art at the time the invention was made to include a decryption technique on the receiver so that the user can view the data.

8. Claims 10 and 11 discuss a method according to claim 1, characterized in that said transaction data are sent from a service user's system (201, 301) to a service provider's (203, 205) system via an open information network (202) and the data related to the acceptance of said transaction are sent to a service provider's (203, 205) system via a closed network (206). Schmitz discloses using the method of claim 1. Claim 1 was rejected based on the discussion(s) above. Schmitz discloses using the method of claim 1 via an open information network (such as a the Internet), as disclosed in claim 1.

9. Claims 14 and 16 discuss an arrangement according to claim 12, characterized in that said closed network (206, 207) is a mobile telephone network or a wireless terminal. Schmitz discloses using the method of claim 12. Claim 12 was rejected based

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on the discussion(s) above. Schmitz discloses on page 2 and lines 44-48, "Wireless telecommunication apparatuses, such as for example mobile or cellular phone (Handie-Talkie is a tradename of the Motorola Communications Division) or pagers, are frequently furnished with the possibility to receive short alphanumeric communications."

10. Claims 7, 17 and 18 discuss a method and arrangement according to claims 1 and 16, characterized in that said code entered at a terminal (207) is a PIN code that can be authenticated by a SIM card (220). Schmitz discloses using the method and apparatus of claims 1 and 16. Claims 1 and 16 were rejected based on the discussion(s) above. Schmitz discloses on page 4 and lines 10-20, "A wireless receiver, for example in the form of a plug-in card, is incorporated as a receiver in the data input apparatus, representing the lowest security level according to the present invention, such that a data transmission is possible to the receiver unit only with this concrete apparatus. In order to increase this security, it can be provided that this wireless receiver can only be operated with a user identification element, for example a magnetic card or a chip card. The user identification element can also operate with graphical methods, such as testing, verification and/or identification of a fingerprint or of a picture identification of the user."

11. Claims 9 and 19 discuss a method and apparatus according to claims 1 and 19, characterized in that the data related to the acceptance of said transaction are encrypted using a service user's terminal (207). Schmitz discloses using the method

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and apparatus of claims 1 and 16. Claims 1 and 16 were rejected based on the discussion(s) above. Schmitz discloses on page 3 and lines 43-55, "The transaction authorization number or the comparable password can be a transaction authorization number for one single use. However, other limitations such as the user time and/or the number or the size of the data files to be transmitted relating are also conceivable for use in determining the validity of the transaction authorization number or of the comparable password. Now, data can be transmitted from the data input apparatus to the receiver unit and vice versa, for example by full duplex, after a connection authorized in the above described manner has been established. It is clear that these data can also be encrypted or encoded first and then transmitted for obtaining additional security."

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 4 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmitz in view of Falk et. al. (US 5,668,876).

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14. Claim 4 discusses a method according to claim 1, characterized in that said transaction is the digital signing of a form. Schmitz discloses using the method of claim 1. Claim 1 was rejected based on the discussion(s) above. Schmitz does not disclose the use of an electronic signature. Falk et. al. teaches on page 2 and lines 6-11, "The personal unit includes a receiver for receiving a transmitted challenge code and an algorithm unit which processes the challenge code, a user input such as a personal identification number (PIN) or electronically recognizable signature, and an internally stored security key for calculating a response code according to a pre-stored algorithm." Therefore it would have been obvious to a person known in the art at the time the invention was made to modify Schmitz in view of Falk et. al. to allow the user to digitally sign the form for ease of use and efficiency purposes.

15. Claim 6 discusses a method according to claim 1, characterized in that the parties associated with the transfer of data are identified by a reliable third party. Schmitz discloses using the method of claim 1. Claim 1 was rejected based on the discussion(s) above. Schmitz does not discuss that a reliable third party identifies parties associated with the transfer of data. Falk et. al. teaches on page 1 and lines 6-9, "The present invention involves a method and an apparatus for authentication of a user attempting to access an electronic service, and, in particular, providing an authentication unit which is separate from preexisting systems." Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was

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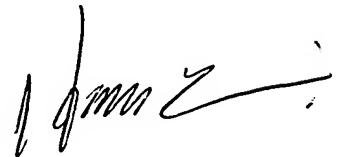
made to modify Schmitz by using Falk to use a third party to identify the parties associated with the transfer of data for added security.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Muriel Tinkler whose telephone number is (571)272-7976. The examiner can normally be reached on Monday through Friday from 7:30 AM until 4 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571)272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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PRIMARY EXAMINER